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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,675	11/27/2001	Masao Okubo	216132US2	8021

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EXAMINER

NGUYEN, TRUNG Q

ART UNIT PAPER NUMBER

2829

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/993,675

Applicant(s)

OKUBO ET AL.

Examiner

Trung Q Nguyen

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 2, 4-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 2 and 10, the specification and drawings as original filed do not provide support for a wire drawing operation. For purposes of examination, "a wire drawing operation" via "wiring drawing dies" now can be treat as an attaching end of the core to a terminal of an electronic component.

Claims 4-9, 11-16 are rejected for being dependent on rejected claims 2 and 10.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2, 4-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Eldridge et al. (U.S. 5,974,662).

Regarding claims 2, 10 and 15-17, Eldridge et al. disclose in Figures 1-2 and in column 12, lines 37-65 a probe card has a structure where nickel alloy is applied to the surface of a core material made of palladium alloy or beryllium copper alloy in addition a wire drawing operation via an attaching end of the core to a terminal of an electronic component with a wire drawing die is performed (column 12, lines 47-55).

Regarding claim 4, Eldridge et al. disclose in column 12, lines 37-45 the non-oxidizable film herein terms are gold, platinum, rhodium, palladium, iridium, etc., and these metals are elements which are thermally diffused into tungsten via upper-most surface of probe. Wherein a wire drawing operation is performed (column 12, lines 37-65).

Claims 5-9, 11-14 and 16 add the limitation wherein the probe diameter is 65 micrometer, nickel alloy plating is 3-15 micrometer, old plating is about 0.2-1.0 micrometer etc. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the probe diameter, thickness of nickel or gold plating dimension to receive the above measurements because it has been held

that changes in shape and size are a matter of obvious design choice, absent any persuasive evidence that the change in configuration was significant.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 2 and 4 have been considered. Some of the arguments are moot in view of the new explanations provided in the rejection for applicant's benefit. The other arguments are not persuasive.

7. *The applicants argue with regard to the rejection under 35 U.S.C 112 that: page 10, lines 7-19 and page 14, lines 11-21 provide support for a wire drawing operation.*

8. The examiner respectfully disagree to the above argues because:

***On page 10, lines 7-19 and page 14, lines 11-21 of the specification only mention "wire drawing operation performed with the wire drawing dies etc." it does not explain what is the wire drawing operation or what is the wire drawing dies. The drawing also does not support these limitations. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in the Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

***Conclusion***

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within two months of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trung Nguyen whose telephone number is 703-305-4925. The examiner can normally be reached on Monday through Friday, 8:30AM – 5:00PM. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5841. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cuneo Kammie can be reached at (703) 308-1233.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0956.

**Trung Nguyen**

Patent Examiner  
Group Art Unit 2829  
September 10<sup>th</sup>, 2003



**EVAN PERT  
PRIMARY EXAMINER**